

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUNORI HASEBE

Appeal No. 95-4747
Application No. 08/063,297¹

HEARD: May 4, 1999

Before JOHN D. SMITH, PAK and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 2-4, 6-11, and 17-28, which are all of the claims pending in this application. Upon the filing of this appeal, the examiner approved entry

¹ Application for patent filed May 19, 1993.

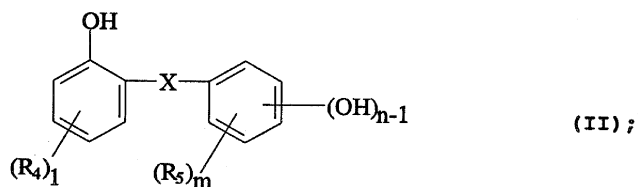
Appeal No. 95-4747
Application No. 08/063,297

(advisories mailed October 25, 1994 and January 09, 1995) of amendments filed October 11, 1994 and December 22, 1994, after the final rejection.

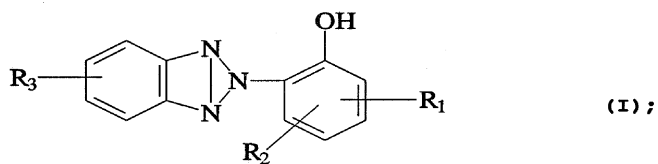
BACKGROUND

The appellant's invention relates to a color photographic material. An understanding of the invention can be derived from a reading of exemplary claim 28, which has been reproduced below.

28. A multiple layer silver halide color photographic material comprising, on a reflective support, a plurality of silver halide emulsion layers, at least one silver halide emulsion layer containing a cyan dye-forming coupler, at least one silver halide emulsion layer containing a magenta dye-forming coupler, and at least one silver halide emulsion layer containing a yellow dye-forming coupler, wherein the silver chloride content of the silver halide emulsion contained in at least one of the emulsion layers is at least 90 mol%; and a plurality of non-photosensitive colloid layers wherein at least one contains an ultraviolet-absorbing agent; wherein said material contains a water-soluble dye, and wherein said silver halide color photographic material comprises, in the non-photosensitive colloid layer furthest from the support containing an ultraviolet-absorbing agent, a dispersion of an emulsified and dispersed mixture of a solution of at least one ultraviolet-absorbing agent represented by formulae (I) or (II), and at least one water-insoluble polymer compound, and a gelatin having an isoelectric point of at least 6.0:



wherein R_1 , R_2 and R_3 each represent a hydrogen atom, a halogen atom, a nitro group, a hydroxyl group, an alkyl group, an alkoxy group, an aryl group, an aryloxy group, or an acylamino group, and R_4 and R_5 each represent a hydrogen atom, an alkyl group, an alkoxy group, or an acyl group, wherein the R_1 , R_2 , R_3 , R_4 and R_5 groups may be substituted, X represents $-CO-$ or $-COO-$, and l, m and n are each an integer of 1 to 4.



art
 of

The prior
 references
 record

Appeal No. 95-4747
Application No. 08/063,297

relied upon by the examiner in rejecting the appealed claims
are:

Sasaki et al. (Sasaki I) 08, 1987	4,692,399	Sep.
Sakai et al. (Sakai) 1989	4,865,957	Sep. 12,
Ishigaki et al. (Ishigaki) 1989	4,879,204	Nov. 07,
Sasaki et al. (Sasaki II) 1991	4,992,358	Feb. 12,
Hayashi 1993	5,206,120	Apr. 27,

Claims 2-4, 6-11, and 17-28 stand rejected under 35
U.S.C.

§ 103 as being unpatentable over any one of Sakai, Sasaki I or
Sasaki II each in view of Hayashi and Ishigaki.

OPINION

We have carefully reviewed the respective positions
advanced by appellant and the examiner. In so doing, we are
constrained to agree with appellant, based on the present
record, that the examiner has not carried the initial burden
of establishing a prima facie case of obviousness with respect
to the subject matter defined by the appealed claims.

Appeal No. 95-4747
Application No. 08/063,297

Accordingly, we shall not sustain the examiner's rejection as follows.

According to appellant, the claims stand or fall together (brief, page 5). We have selected claim 28, the only independent claim on appeal, as a representative claim upon which the present decision is based.

It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one having ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Following that basic rule of claim interpretation, we determine that claim 28 specifies a color photographic material that includes at least five layers including at least two non-photosensitive layers and at least three silver halide containing emulsion layers provided on a reflective support. At least one silver halide containing emulsion layer of each of cyan, magenta, and yellow dye-forming couplers are formed. The photographic material includes plural non-photosensitive

colloid layers with at least one containing an ultraviolet absorbing agent. The non-photosensitive colloid layer containing an ultraviolet absorbing agent which is furthest from the support includes a water-insoluble polymer and a gelatin. The latter layer is obtained from a dispersion of an emulsified and dispersed mixture of a solution of at least one ultraviolet absorption agent obtained from a class of compounds defined by two separate claimed formulas, at least one water insoluble polymer compound, and a gelatin having an isoelectric point of at least 6.0. The photographic material contains a water-soluble dye and at least one of the silver halide emulsion layers includes a 90 mole percent silver chloride content.

In our view, the examiner has failed to set forth a cogent explanation as to why a skilled artisan would have been led or motivated by the applied secondary references and the undisputed factual assertions of the examiner (page 8 of the nonfinal office action mailed September 8, 1993, pages 7 and 8 of the final rejection and pages 5 and 6 of the answer)² to

² Appellant's arguments and call for an affidavit fall
(continued...)

modify the photographic materials of any of Sakai, Sasaki I or Sasaki II to include a non-photosensitive colloid layer containing at least one ultraviolet absorption agent, at least one water insoluble polymer compound, and a gelatin having an isoelectric point of at least 6.0 in the position as claimed. In this regard, we note that even if the applied reference teachings and asserted "common knowledge" would have rendered the use of a separate non-photosensitive layer containing a water insoluble polymer compound in any of Sakai, Sasaki I or Sasaki II prima facie obvious, that combination of layers would not result in the claimed photographic material wherein the specified at least one ultraviolet absorption agent is present in the same layer as the water insoluble polymer compound and the gelatin having an isoelectric point of at least 6.0.

To establish a prima facie case of obviousness, an examiner must explain why the teachings from the prior art itself would have suggested the claimed subject matter to one

²(...continued)
short of a specific denial of each of the facts asserted by the examiner. See In re Fox, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973).

Appeal No. 95-4747
Application No. 08/063,297

of ordinary skill in the art. See In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a prima facie case of obviousness. See In re Fritsch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

In our view, the motivation relied upon by the examiner for combining the teachings of the references to arrive at appellant's claimed invention herein appears to have come from the disclosure of appellant's invention in his specification rather than from the prior art. Accordingly, based on the present record, the applied prior art would not have rendered the specifically claimed process herein prima facie obvious.

Because we reverse on the basis of failure to establish a prima facie case of obviousness, we need not reach the issue of the sufficiency of appellant's showing of alleged unexpected results. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

Appeal No. 95-4747
Application No. 08/063,297

For the above reasons, we find that the examiner has not set forth a factual basis which is sufficient to support a conclusion of obviousness of appellant's claimed invention.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2-4, 6-11, and 17-28 under 35 U.S.C. § 103 as being unpatentable over any one of Sakai, Sasaki I or Sasaki II each in view of Hayashi and Ishigaki 12-16 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
PETER F. KRATZ)	

Appeal No. 95-4747
Application No. 08/063,297

Administrative Patent Judge)

bae

Appeal No. 95-4747
Application No. 08/063,297

Burns, Doane, Swecker & Mathis
George Mason Building
Washington and Prince Streets
P.O. Box 1404
Alexandria, VA 22313-1404